

### **REMARKS**

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 12, 14-22, 29, and 30 are presently active in this case. Claims 1-11, 13, 23-28, and 31-37 have been canceled without prejudice or disclaimer.

The present Amendment amends Claims 14, 20, 22, 29, and 30 without introducing any new matter as these changes are clearly supported by FIG. 1 and page 3, lines 9-13, of the specification, for example.

The outstanding Office Action rejects Claims 12, 14-22, 29, and 30 under the first paragraph of 35 U.S.C. §112 as being based on a non-enabling disclosure; rejects Claim 20 under the second paragraph of 35 U.S.C. §112 as being indefinite; rejects Claims 12, 14, 15, 17, 21, and 22 under 35 U.S.C. §103(a) as unpatentable over Bauer, II (U.S. Patent No. 3,692,394, herein "Bauer") in view of Ohshima et al. (U.S. Patent No. 4,821,911, herein "Oshima") and further in view of Glenn (U.S. Patent No. 4,667,226); rejects Claims 16, 18, and 19 under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Glenn and further in view of Okada et al. (U.S. Patent No. 4,758,905, herein "Okada"); rejects Claims 29 and 30 under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Glenn and further in view of Hines (U.S. Patent No. 6,122,455); and rejects Claim 20 under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Glenn, and further in view of Anderson (U.S. Patent No. 6,215,523).

The rejection of Claims 12, 14-22, 29, and 30 under 35 U.S.C. §112, first paragraph, as being based on a non-enabling disclosure is traversed. The PTO has clearly misinterpreted the disclosure of FIG. 1 and the previous language of Claims 12, 14-22, 29, and 30 as suggesting that the internal construction of the viewfinder is "critical," because the previously presented versions of Claims 12, 14-22, 29, and 30 recited not changing the optical axis of

the viewfinder. However, the viewfinder optical axis being referenced was clearly on the optical path between the viewfinder 3 and the shutter 2 that is completely outside the optical viewfinder as illustrated in FIG. 1. The PTO cannot continue to misinterpret the claims as the location and external nature of the optical path that leads to the light receiving portion of the viewfinder from the shutter has been set forth so that these relationships should be clear even to the lay person, much less those of ordinary skill in the art. It should further be clear that the internal construction of the optical viewfinder is not “critical” as inappropriately asserted by the PTO. Accordingly, withdrawal of this rejection is respectfully submitted to be in order.

In response to the rejection of Claim 20 under the second paragraph of 35 U.S.C. §112 as being indefinite, the PTO appears to suggest that the words “the” or “said” have been presented in Claim 20 before the recital “processing means.” No such words requiring a previous recital of this “processing means” are presented by Claim 20. Accordingly, withdrawal of this rejection is respectfully submitted to be in order.

Turning to the rejection of Claims 12, 14, 15, 17, 21, and 22 under 35 U.S.C. §103(a) as unpatentable over Bauer in view of Ohshima and Glenn, this rejection is traversed as lacking establishment of a reasonable *prima facie* case of obviousness.

Turning to the rationale in the outstanding rejection that was applied as to the subject matter of independent Claims 14 and 22 being in part taught by Glen, the outstanding Action appears to ignore the fact that the rotating shutter 101 of Glen is taught to be between two cameras 130 and 140 that have different scan rates and not between even one camera and an element that will provide a reflected portion to a view finder having no scan rate. Missing from the outstanding Action is the required “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” set forth by the court in *In re Kahn*, 78 USPQ2d 1329, 1336 (Fed. Cir 2006).

In this regard, the optical viewfinder relied on from Bauer is eyepiece 28 and this “eyepiece” has no scan rate to be matched to film 20 because film 20 has no scan rate. Even assuming that the artisan could be reasonably said to find it obvious to completely reconstruct and redesign the photographic motion picture camera of Bauer so as to replace the motion picture film 20 and film guide 18 of Bauer with the complex optics in adapter 2 and the image pickup elements 9A-9C and associated optics in the television body 7 of Ohshima, a matter treated below to be in clear violation of established precedent, the fact remains that the eyepiece 28 of Bauer with prism 24 is still relied on to read as the claimed “viewfinder” of independent Claim 14 and “viewfinder means” of independent Claim 22 that provide “vision over a wide field.” As this eyepiece 28 of Bauer with prism 24 has no “scan rate,” the unanswered question in the outstanding Action is still why the artisan would have modified the rotation control circuit of Bauer that is designed to drive the shutter at constant speed when the camera is operating, and to automatically stop the shutter in one of the blocking positions (to reflect light to the eyepiece when the camera is not operating, see col. 2, lines 21-28 of Bauer) to operate as the Glenn shutter 101 does to direct light to each of two different cameras having different scan rates at appropriate times related to a video signal.

In addition, the basic premise offered in support of the combination of Bauer and Ohshima is clearly flawed.

Bauer, relied upon by the outstanding Office Action as a primary reference to form the 35 U.S.C. §103(a) rejections, describes a motion picture camera, where the images are reflected by the forward surface 22 to the reflecting prism 24 and a lens system 26 to an eyepiece 28. As illustrated in Bauer’s Figure 1, the optical path is deflected twice, first by the rotary reflective shutter 16 and then by the prism 24 to get to the eyepiece 28 through the lens holder 26. Apparently now realizing that the prism 24 will change the direction of the optical path from the shutter to the eyepiece 28, the PTO attempts to create a teaching that

prism 24 and eyepiece 28 together form a viewfinder. However, this teaching is the creation of the PTO not that of Bauer and it is like the PTO attempt to create reference teachings that were not in the reference relied on in *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Specifically, there is no evidence here that Bauer in any way teaches that the eyepiece 28 and prism 24 together form a “viewfinder” as the eyepiece alone performs the function of providing vision over a wide field. Moreover, the prism 24 is not even shown or described to be held by the lens system 26 that leads the light from the separated prism 24 to the eyepiece 28 as described at col. 2, lines 4-10 and shown by FIG. 1. Therefore, Bauer ***fails to teach or suggest*** a shutter configured to direct the light to the viewfinder without further change of the optical path leading to the light receiving portion of the viewfinder.

In addition, and as noted above, the apparent reliance on Ohshima to suggest the complete reconstruction and design of the mechanical and optical elements of Bauer is contrary to established precedent. See *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA (CCPA 1959) reversing an obviousness rejection where the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle” under which the basic reference was designed to operate. Here the Bauer construction was “designed to operate” as a motion picture camera, an operation impossible if the motion picture film is eliminated.

Moreover, reference modifications that would render a reference unsatisfactory for its intended purpose are also not obvious. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the purpose is that of filming a motion picture, not making high speed video recordings that require the addition of the adapter elements 2 and the TV camera elements in 7 of Ohshima.

The rationale offered in the outstanding Action is little more than suggesting that various subcombinations forming the claimed combination were known in the art as parts of unrelated combinations with other elements. This rationale cannot be used to establish a valid *prima facie* case of obviousness, see *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) as follows:

If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

The rejection of Claims 14 and 22 as unpatentable over Bauer in view of Ohshima and further in view of Glenn is therefore traversed.

As Claims 12, 15, 17, and 21 depend from Claim 14, the rejection of these claims on this grounds is likewise traversed for the reasons noted above and because of the further features added by each of these claims that are also not taught or suggested by these applied references.

Turning to the rejection of Claims 16, 18, and 19 under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Glenn and further in view of Okada and the rejection of Claims 29 and 30 under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Glenn and further in view of Hines, it is noted that Hines and Okada also fail to teach or suggest Applicant's claimed invention and fail to cure the shortcomings of Bauer, Ohshima, and Glenn that are set forth above. Accordingly, as Claims 16, 18, 19, 29, and 30 depend from one of the above-noted independent Claims 14 or 22, these rejections are likewise traversed for the reasons noted above and because of the further features added by each of these claims that are also not taught or suggested by these applied references.

Claim 20 stands rejected under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, and Glenn, and further in view of Anderson.

Since independent Claim 20 and independent Claims 14 and 22 recite analogous features and Anderson fails to cure the shortcomings of Bauer, Ohshima, and Glenn that are set forth above, the rejection of Claim 20 is traversed for the reasons set forth above as to Claims 14 and 22.

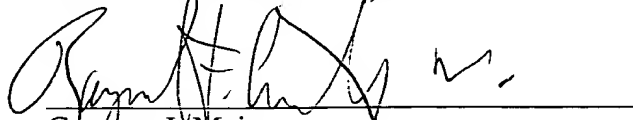
In addition, it is believed to be clear that the feature added by Claim 20 ("a screen configured to display the synthesis of the light components after passage into processing means") is not taught or suggested by any of the references being relied upon. Accordingly, Claim 20 is further submitted to be patentable for this reason as well.

Consequently, in view of the present amendment and traversals, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance.

Should the Examiner believe that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Gregory J. Maier  
Attorney of Record  
Registration No. 25,599

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)

Raymond F. Cardillo, Jr.  
Registration No. 40,440